

## **REMARKS**

Entry of the foregoing amendments is respectfully requested.

### **Summary of Amendments**

By the foregoing amendments, claims 1 and 3-18 are cancelled and claims 19-64 are added, whereby claims 19-64 are pending, with claims 19, 41 and 64 being independent claims.

Support for the new claims can be found in original claims 1-10 and throughout the present specification, for example, at pages 5, 8 and 9 thereof.

Applicants point out that the cancellation of claims 1 and 3-18 is without prejudice or disclaimer, and Applicants expressly reserve the right to prosecute the cancelled claims in one or more continuation and/or divisional applications.

### **Summary of Office Action**

Claims 1, 3, 4, 6, 7, 11 and 18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. published patent application 2002/0028875 by Anderle et al. (hereafter "ANDERLE") in view of U.S. Patent No. 6,372,876 to Kim et al. (hereafter "KIM"), in view of U.S. Patent No. 5,399,563 to Stein et al. (hereafter "STEIN"), and in view of the Handbook of Cosmetic Science and Technology (hereafter "HANDBOOK").

Claims 8-10 and 12-17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over ANDERLE in view of KIM, STEIN, and HANDBOOK, and further in

P29685.A01

view of U.S. Patent No. 6,258,963 to Koch et al. (hereafter "KOCH") and U.S. Patent No. 5,989,528 to Tanner et al. (hereafter "TANNER").

Claim 5 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over ANDERLE in view of KIM, STEIN, and HANDBOOK, and further in view of U.S. Patent No. 5,725,844 to Gers-Barlag et al. (hereafter "GERS-BARLAG").

### **Response to Office Action**

Reconsideration and withdrawal of the rejections of record are respectfully requested in view of the foregoing amendments and the following remarks.

#### ***Response to Rejection of Claims 1, 3, 4, 6, 7, 11 and 18 under 35 U.S.C. § 103(a)***

Claims 1, 3, 4, 6, 7, 11 and 18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over ANDERLE in view of KIM, in view of STEIN, and in view of HANDBOOK. The rejection essentially asserts that ANDERLE discloses plasticized waterborne polyurethane dispersions, personal care compositions comprising the waterborne polyurethane dispersions and sunscreens broadly. The rejection also points to section [262] of ANDERLE wherein a sunscreen lotion composition is allegedly exemplified. The rejection concedes that ANDERLE fails to disclose, *inter alia*, oil-in-water emulsions and microemulsions. In this regard, the rejection relies on KIM which allegedly discloses water-soluble or water-dispersible polyurethanes as aids in cosmetic compositions, and on HANDBOOK which allegedly teaches emulsions as promoting cosmetic elegance and allowing otherwise impractical combinations of ingredients, i.e.,

P29685.A01

oil soluble and water soluble materials, to be used in the same product. The rejection further relies on STEIN which allegedly exemplifies oil-in-water sunscreens as preferred sunscreen formulations. Based on the foregoing allegations, the Examiner takes the position that the subject matter of the rejected claims would allegedly have been obvious to one of ordinary skill in the art.

Applicants respectfully traverse this rejection. Specifically, ANDERLE qualifies as prior art only under 35 U.S.C. § 102(e) because it was published only on March 7, 2002, i.e., after the filing date of the present application (i.e., December 14, 2001). The filing date of ANDERLE is July 18, 2001. Also, ANDERLE is a non-provisional of provisional application No. 60/219,560 filed July 20, 2000.

ANDERLE was filed after the priority date of the present application, i.e., the filing date of German Application 100 63 130.4 (filed December 18, 2000). Applicants herewith submit a verified English language translation of German Application 100 63 130.4. All of the present claims are supported by the German Application (which is substantially identical with the present application). Accordingly, only the disclosure of the provisional application No. 60/219,560 of which ANDERLE is a non-provisional can qualify as prior art for the present claims.

Also submitted herewith is a copy of provisional application No. 60/219,560 (downloaded from the public PAIR website of the USPTO)<sup>1</sup>. A review of this provisional

---

<sup>1</sup> In accordance with M.P.E.P. § 609C(3), the document cited above in support of Applicants' remarks is being submitted as evidence directed to an issue raised in the mentioned Official Action, and no additional fee or Certification pursuant to 37 C.F.R. §§ 1.97 and 1.98, or citation on a FORM PTO-1449 is believed to be necessary.

P29685.A01

application reveals that it does not contain the disclosure of ANDERLE on which the present rejection is based. In particular, the provisional application does not mention sunscreens at all, let alone a composition containing a sunscreen and a polyurethane.

Regarding the waterborne polyurethane dispersions described therein, the provisional application states that these dispersions have higher solids and produce articles having lower modulus and other improved properties compared to articles made from dispersions prepared using the prior art diluents (page 3, first paragraph). Regarding potential applications of these dispersions the provisional application mentions gloves; papers and non-wovens; fibrous materials such as textiles (including application to upholstery, carpets, tents, awnings, clothing, and the like); films, sheets, composites, and other articles; inks and printing binders; flock and other adhesives; and personal care products such as cosmetics, hair sprays, and nail polish; and the like (page 18, end of first paragraph). The test methods described at pages 21-23 of the provisional application relate exclusively to gloves made from the polyurethane dispersions.

Nowhere does the provisional application teach or suggest a cosmetic or dermatological formulation and/or an OW formulation, let alone a formulation which comprises a UV filter substance. Of course, the provisional application also fails to teach or suggest the use of the polyurethane dispersions described therein for improving the water resistance of corresponding formulations.

None of the remaining documents cited by the Examiner cures the deficiencies of the provisional application on which ANDERLE is based, and there is not even

P29685.A01

motivation to combine the teachings of these documents with the teaching of the provisional application.

Specifically, KIM is *prima facie* directed to the use of polyurethanes which are soluble or dispersible in water as aids in cosmetic and pharmaceutical compositions (see title). A closer look at KIM reveals that this document is primarily concerned with hair treatment compositions. For example, while KIM mentions in col. 6, lines 13-15 that “[t]he polyurethanes described above are used not only in hair cosmetics but also in creams and in the drugs sector as tablet coating compositions and tablet binders”, the specific formulations listed in the table in col. 8 are exclusively aerosol hair sprays, manual pump sprays and hair setting compositions. Additionally, claim 1 of KIM is directed to a method of treating hair.

Nowhere does KIM teach or suggest a cosmetic or dermatological formulation and/or an O/W formulation, let alone a formulation which comprises a UV filter substance. KIM also fails to teach or suggest the use of the polyurethanes described therein for improving the water resistance of corresponding formulations.

STEIN merely discloses certain benzylidene-quinuclidinones and their use in cosmetic and/or pharmaceutical preparations (see abstract). These preparations are employed as UV protectants and for the treatment of inflammation and/or allergies (see, e.g., claims 11 and 12 of STEIN).

HANDBOOK is concerned generally with emulsions and their use in cosmetics.

For at least all of the foregoing reasons, even a combination of the teachings of the ANDERLE provisional application, KIM, STEIN and HANDBOOK fails to teach or

P29685.A01

suggest the subject matter of any of the present claims. Accordingly, the claim rejection under 35 U.S.C. § 103(a) over these documents is without merit and should be withdrawn, which action is respectfully requested.

***Response to Rejection of Claims 5, 8-10 and 12-17 under 35 U.S.C. § 103(a)***

Dependent claims 5, 8-10 and 12-17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over ANDERLE in view of KIM, STEIN, and HANDBOOK, i.e., the documents applied against claims 1, 3, 4, 6, 7, 11 and 18, and further in view of GERS-BARLAG (claim 5) or in view of KOCH and TANNER, respectively. The rejection essentially alleges that the elements recited in the rejected claims are taught or suggested in the additionally cited documents.

This rejection is respectfully traversed as well. As set forth in detail above, the rejection of claims 1, 3, 4, 6, 7, 11 and 18 under 35 U.S.C. § 103(a) over ANDERLE in view of KIM, STEIN, and HANDBOOK is without merit. The same necessarily applies to the rejection of the remaining claims which are all dependent from these rejected claims. Accordingly, withdrawal of the rejection of claims 5, 8-10 and 12-17 is warranted and respectfully requested.

**CONCLUSION**

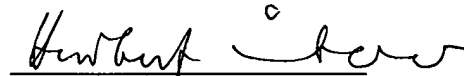
In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully

P29685.A01

invited to contact the undersigned at the telephone number below.

Applicants point out that an Information Disclosure Statement is being filed concurrently herewith. The Examiner is respectfully requested to indicate consideration thereof by returning a signed and initialed copy of the Form PTO-1449 submitted therein with the next communication from the Patent and Trademark Office.

Respectfully submitted,  
Anja KNUPPEL et al.

A handwritten signature in dark ink, appearing to read "Neil F. Greenblum", written over a horizontal line.

Neil F. Greenblum  
Reg. No. 28,394

Heribert F. Muensterer  
Reg. No. 50,417

April 5, 2006  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191